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09/586,977	06/05/2000	Bruno Basquin	032326-031	8497

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EXAMINER
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TRAN, TONGOC

ART UNIT	PAPER NUMBER
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2134

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DATE MAILED: 05/18/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/586,977

Applicant(s)

BASQUIN, BRUNO

Examiner

Tongoc Tran

Art Unit

2134

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 10 February 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 4, 6-8, 10-19, 20-24 is/are rejected.
- 7) ☒ Claim(s) 2, 3, 5 and 25-27 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

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### **DETAILED ACTION**

1. This office action is in response to applicant's amendment filed on 2/10/2004.

Claims 20-27 are added. Claims 1-27 are pending.

### ***Response to Arguments***

2. Applicant's arguments filed on 2/10/2004 have been fully considered but they are not persuasive.

Response to Applicant's remark to U.S.C. 102 Rejection:

Applicant contends that Rikuna does not teach the second card contains a program to be executed at the terminal that linked to a telecommunication network and the first card and the second card does not authenticated against one another. Examiner likes to point out that Rikuna teaches that the second card is an IC card which contains a system program, a system controller and a calculation section etc. which requires a program to perform various functions (see Fig. 4). Furthermore, Rikuna teaches in col. 3, lines 22-23 that the card terminal is installed near the cash register to perform cash transaction. Rikuna further teaches that the cash transaction is on-lined with a credit company (col. 8, lines 52-55) which suggests that the terminal is linked to a telecommunication network. Rikuna also discloses information stored in one card is used to authenticate the information stored in another card (see col. 2, line 15-col. 3 line 13).

Response to Applicant's remark to U.S.C. 103 Rejection:

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Applicant contends that the rejected prior art Shona teaches a mutual authentication between an IC card and a host device and Turban teaches communication between plurality of IC card on the same communication terminal would not lead a person of ordinary skill in the art to Applicant's invention that the first IC card and the second IC authenticating one another on the same terminal. Examiner respectfully disagrees. Shona teaches a mutual authentication with a host device which suggests security of communication between two devices. Turban discloses that the advantage of his invention of having user relevant data stored directly in the chip card instead of transmitting over the telecommunication terminal would considerably reduces the burden of communication traffic (col. 2, lines 5-17). Turban further discloses means for the chip card to authenticate the user (col. 3, lines 38-44). Since Turban suggests that the advantage of having all the user information on the chip card would reduce the network communication burden. Therefore, it would have been obvious for Shona's mutual authentication between the IC card with the host device to combine with Turban's exchanging data communication between chip cards to reduce the network traffic.

In response to Applicant's remark to claim 12, Applicant contends that Shona does not disclose one of the cards in the telecommunication terminal is authenticated by a remote server. However, Turban discloses the chip card is used to authenticates the user to the network (col. 3, lines 38-53).

Applicant's arguments in respect to 2-3 5 and 9 have been fully considered and are persuasive. The rejection for 2-3, 5 and 9 have been withdrawn.

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***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by Rikuna (U.S. Patent No. 4,752,678).

In respect to claim 1, Rikuna discloses a processor for pre-controlling the execution of a program contained in a second chip card, inserted in a terminal, in addition to a first chip card, containing data and connected to a telecommunication network to which the terminal is linked comprising the step of authenticating one of the first and second cards by the other, prior to the execution of the program (see col. 2, line 67-col. 3, line 13).

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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Claims 1, 4, 6, 8, 10-19, 20-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shona (U.S. Patent No. 5,799,085) in view of Turban (U.S. Patent No. 5,586,166).

In respect to claim 1, Shona discloses a processor for pre-controlling the execution of a program contained in a second chip card, inserted in a terminal, in addition to a first host device, comprising the step of authenticating one of the host device and second cards by the other, prior to the execution of the program (see col. 2, lines 43-54).

Shona does not explicitly disclose said host device is a chip card and the second chip card is connected to a telecommunication network to which the terminal is linked. However, Turban discloses a chip card with means for checking whether a further chip card has been installed into the same telecommunication terminal and two chip cards can received signals and useful data from one another (see col. 3, lines 18-26). Therefore, It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the Shona's mutual authentication system with Turban's plurality chip card communicating over the telecommunication network for the benefit of enabling the chip card to make direct data exchange between telecommunication network and chip card (col. 2, lines 41-49).

In respect to claim 4, Shona and Turban disclose the process of claim 1. Shona further discloses wherein the authentication involves an authentication of the second card by the first card, and comprises the following steps:

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transmitting a random number from the first card to the second card (see col. 2, lines 63-67);

applying the transmitted random number and a key to an algorithm contained in the second card to produce a signature that is transmitted to the first card (see col. 3, lines 1-5);

applying the random number and a key to an algorithm containing in the first card to produce a result (see col. 3, lines 5-8); and

comparing the result to the signature transmitted to the first card as to execute the program only when the two are equal (see col. 3, lines 8-12).

In respect to claim 6, Shona and Turban disclose the process in according to claim 1 wherein the authentication involves an authentication of the first card by the second card, and comprises the following steps:

transmitting a predetermined field of a number from the first card to the second card (see col. 3, lines 15-21); and

comparing the predetermined field to a number in the second card so as to execute the program or to read its content only when the two are equal (see col. 3, lines 22-30).

In respect to claim 8, Shona and Turban disclose the process in according to claim 1. Shona further discloses wherein the authentication involves an authentication of the first card by the second card, and comprises the following steps:

reading a random number from the first card into the second card (see col. 3, lines 15-18);

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applying the random number and a key to an algorithm contained in the first card so as to produce a signature transmitted to the second card (see col. 3, lines 18-21);

applying the random number and a key to an algorithm contained in the second card so as to produce a result (see col. 3, lines 22-26); and

comparing the result to the signature transmitted to the second card so as to execute the program or read its content only when the two are equal (see col. 3, lines 2, lines 24-30).

In respect to claim 10, Shona and Turban disclose the process in accordance with claim 1. Shona further discloses said process comprising a first authentication of one card by the other card and a second authentication of the other card by said one card which follows the first authentication when said one card is authenticated by the other card and which is followed by the execution of the program when the other card is authenticated by said one card (see col. 2, line 63-col. 3, line 30).

In respect to claim 11, Shona and Turban disclose the process of claim 1. Shona further discloses wherein at least one part of the authentication is executed only in response to an authentication request, transmitted from the second card to the first card (see col. 2, lines 63-67).

In respect to claim 12, Shona and Turban disclose the process of claim 1. Turban further discloses wherein authentication steps are executed in a server of the telecommunication network in response to a request from the first card (see col. 3, lines 37-46).



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In respect to claim 13, Shona and Turban disclose the process according to claim 1. Shona further discloses said process including the steps of reading of the characteristics for the execution of the program in the second card, by the first card or the terminal in response to an introduction of the second card in a reading means linked to the terminal, and analysis of the characteristics in comparison to the material and software capacities of the first card and/or the terminal to reject the second card when said characteristics are incompatible with the first card and/or the terminal (see col. 2, line 63-col. 3, line 12).

In respect to claim 14, Shona and Turban disclose the process in accordance with claim 1. Turban further discloses including the step, between the authentication of card and the execution of the program, of remotely loading the program from the second card into the first card for a program execution in the first card (see col. 4, lines 57-64).

In respect to claim 15, Shona discloses Turban disclose the process in accordance with claim 1. Turban further discloses wherein the program is launched on command from the first card to be executed in the second card and exchanges of commands and responses are made between the second card and the terminal (see col. 4, lines 57-64).

In respect to claim 16, Shona and Turban disclose the process of claim 15. Turban further discloses wherein said exchanges are made directly between the second card and the terminal (see col. 4, lines 57-64).

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In respect to claim 17, discloses the process of claim 15, wherein said exchanges between the second card and the terminal are made through the first card (see col. 3, lines 48-52).

In respect to claim 18, Shona and Turban disclose the process of claim 1. Shona further including the step, between the authentication of card and the execution of program, of remotely loading the program from the second card into the terminal for program execution in the terminal (see col. Col. 4, lines 57-64).

In respect to claim 19, Shona and Turban disclose the process of claim 1. Turban further discloses wherein the telecommunication network is a radio telephone network, the terminal is a mobile radio telephone terminal, and the first card is a subscriber identity card (see col. 2, lines 22-31 and col. 4, lines 1-3).

In respect to claim 20, Shona disclose a process for executing an application program in a terminal of a telecommunication network having a first, SIM card containing subscriber identification and communication information, and a second, program card containing the application program to be executed, comprising the following steps:

transmitting, from said second card to the host device, information pertaining to the application program to be executed; authenticating said second card via said host device, based upon said transmitted information; and executing said program contained in the second card if the authentication is successful (see col. 1, lines 53-col. 2, lines 43-60).

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Shona does not explicitly disclose said host device is a sim card linking the second card to the communication network. However, Turban discloses a chip card with means for checking whether another chip card has been installed into the same telecommunication terminal and two chip cards can received signals and useful data from one another (see col. 2, lines 23-30 and col. 3, lines 18-26). Therefore, It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the Shona's mutual authentication system with Turban's plurality chip card communicating over the telecommunication network for the benefit of enabling the chip card to make direct data exchange between telecommunication network and chip card (col. 2, lines 41-49).

respect to claim 21, Shona and Turban disclose the process of claim 20, wherein said authenticating step is performed, at least in part, by a server remote from said terminal, in response to a request from said first card (see Turban, col. 4, lines 1-15).

In respect to claim 22, Shona and Turban disclose a process of claim 20, further including the step of authenticating said first card by said second card, prior to executing said program (see Turban, col. 3, lines 18-26).

In respect to claim 23, Shona and Turban disclose the process of claim 20, wherein said transmitted information includes an identifier of the application program (see Turban, col. 3, lines 18-57).

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In respect to claim 24, Shona and Turban disclose the process of claim 20, wherein said transmitted information includes characteristics required for the execution of the application program (see Turban, col. 3, lines 18-57).

5. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Shona (U.S. Patent No. 5,799,085) and Turban (U.S. Patent No. 5,586,166) as applied to claim 2 above, and further in view of Jandrell (U.S. Patent No. 5,365,516).

In respect to claim 7, Shona and Turban disclose the process of claim 6. Shona and Turban do not explicitly disclose wherein the predetermined field comprises at least the call sign of the telecommunication network contained in an identity number of the first card. However, Jandrell discloses using a call sign of the telecommunication network as a system identifier code (see col. 24, lines 19-27). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to utilize the teaching of Jandrell by using the call sign as an identification code for the benefit of keeping record for service request and maintaining control.

***Allowable Subject Matter***

6. The following is a statement of reasons for the indication of allowable subject matter:

Claims 2-3, 5, 9 and 25-27 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

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In claims 2, 3, 5, 9 and 25, the cited prior art, Rikuna, Shona and Turban, alone or in combination, does not explicitly teach the steps of :

applying an identifier of the program which is transmitted from the second card to the first card and a key to an algorithm, contained in the first card, to produce a result, and comparing the result and a certificate which is transmitted by the second card to the first card in order to execute the program only in case the latter two are equal (claim 2).

selecting the key in a table of keys contained in the first card as a function of the program identifier (claims 3, 5, 9 and 25).

### ***Conclusion***

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tongoc Tran whose telephone number is (703) 305-7690. The examiner can normally be reached on 8:30-5:00 M-F.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gregory A. Morse can be reached on (703) 308-4789. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Examiner: Tongoc Tran  
Art Unit: 2134

TT

May 7, 2004

*Matthew D. Smithers*  
**MATTHEW SMITHERS**  
**PRIMARY EXAMINER**  
*Art Unit 2137*